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JUN 22 2009

OFFICE OF PETITIONS

In re Application of :
Mohan Kalkunte et al. :
Application No. 10/648,573 : DECISION ON RENEWED PETITION
Filed: August 26, 2003 : PURSUANT TO
Attorney Docket No.: 14221US02 : 37 C.F.R. § 1.181(A)
Title: METHOD AND SYSTEM FOR :
HANDLING TRAFFIC FOR SERVER :
SYSTEMS :
:

This is a decision on the renewed petition filed June 12, 2009, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This renewed petition pursuant to 37 C.F.R. § 1.181(a) is DISMISSED.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the Office communication mailed June 6, 2008, which set a shortened statutory period for reply of one month. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on July 7, 2008. A notice of abandonment was mailed on December 23, 2008.

RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable (emphasis added). It is expected that the record would include, but not be limited to, the application

number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions):

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

PROCEDURAL HISTORY AND ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on January 6, 2009, where Petitioner stated that the notice of June 6, 2008 was not received at the correspondence address of record.¹ The original petition was dismissed via the mailing of a decision on April 14, 2009.

With this renewed petition, Petitioner has indicated that Office communications are entered into a commercially available

¹ Original petition, page 2 and Howard statement of facts, paragraph 3.

electronic docketing system,² and that a search of the file jacket and the application file contents was performed, and this search indicates that the notice of June 6, 2008 was not received.³ Moreover, Petitioner has indicated that a master docket does not exist,⁴ and has provided a copy of the file jacket,⁵ a print-out of the docket that is associated with this particular application,⁶ and copies of "Actions Due Reports."⁷

However, the statement that Petitioner has included describing the system used for recording an Office action received at the correspondence address of record with the USPTO is insufficient to either describe the docketing system or establish the reliability of the same, in that it is silent as to how this docketing system serves to ensure that the correspondence recorded therein is responded to in a timely manner. On second renewed petition, Petitioner should address the following inquiries:

- Does this computer-based docketing software program generate reports on a periodic basis? If so, are these reports distributed to the responsible attorney?
- Does it generate periodic reminders prior to the due dates? If so, are these reminders distributed to the responsible attorney?

A description of the pages entitled "Patent Actions Due Report" has not been provided. If these pages constitute reminders that are generated by the electronic docketing system, and if these pages are distributed to the responsible attorney on a periodic basis, this should be explicitly stated on second renewed petition.

CONCLUSION

The time period for filing a second renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, if reconsideration of this decision is desired, any response to this decision must be submitted within TWO MONTHS from the mail date of this decision, and extensions of time under 37 C.F.R. § 1.136(a) are not permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.181(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

2 Beremski statement of facts, paragraph 2.

3 Id. at 5.

4 Id. at 6.

5 Exhibit A.

6 Exhibit B.

7 Exhibits C-E.

The second renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,⁸ hand-delivery,⁹ or facsimile.¹⁰ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.¹¹

The alternate petition under 37 C.F.R. §1.137(b) which was submitted on January 6, 2009 will be held in abeyance so as to afford Petitioner the opportunity to file a renewed petition to have the holding of abandonment withdrawn - the associated fee has not been charged to Petitioner's Deposit Account. If Petitioner would prefer to seek revival under the unintentional standard, a response to this decision should be submitted with words to this effect.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.¹² All other inquiries concerning examination procedures should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions

⁸ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁹ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

¹⁰ (571) 273-8300- please note this is a central facsimile number.

¹¹ <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

¹² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).